

## Remarks

### ***Provisional Double Patenting Rejections***

The examiner is requested to reconsider the provisional double patenting rejection as the provisionally rejected claims are now canceled.

### ***Claim Rejections – 35 U.S.C. § 103(a)***

In the Office action, claims 1-30 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Zigmond in view of Dedrick. New claims 31-60 are patentably distinguished over the cited art at least for the reasons expressed herein.

New claim 31 recites *storing content...in a cache coupled to a receiver*. Simply, Zigmond does not cache content. For example, in Zigmond, video programming is streamed to a video switch 90 and is output for display without being cached. See Figure 5. While the programming delivery is not explained in connection with Figure 5, it is discussed briefly in connection with Figure 4. In Figure 4, the programming source that feeds a video switch is item 66. The item 66 may be, for example, national broadcasters or cable network, as indicated in column 8, lines 43-51. The video programming feed 52 is described as any suitable program delivery channel such as over-the-air broadcasts, a cable provider, consumer satellite service, telephone lines, the Internet, or any other system. See column 7, lines 16-21. Thus, video is being streamed from the video source to the switch in Figure 4 and there is no reason to believe anything different happens in Figure 5 since nothing different is explained.

Additionally, the language in column 15, lines 24-35, cannot be read to teach storing both the content and the advertisement. The advertisement repository only has a cache of advertisements. See column 15, lines 24-25. It is explained further down that the advertising repository “may comprise any computer readable medium capable of storing digitally encoded video programming and later making the encoded programming available for display to a user.” This language does not indicate that the advertisement repository also stores the streaming content. The language merely indicates that the repository must have a medium that is capable of storing encoded video programming, not one that stores a streaming content. Since advertisements may be video, Zigmond apparently believed that it was valuable to have the advertisement repository be one that is capable of storing advertisements (like TV advertisements) in the form of digitally encoded video programming.

Nothing elsewhere in Zigmond suggests that the advertising repository store both the advertisement and the content. No figure shows a storage that could store the content. Moreover, the programming delivery, indicated by the arrow to the left of the video switch 90 (Figure 5), would make no sense since there would be no programming delivery. Instead, there would be nothing other than the ad delivery, indicated by an arrow adjacent the ad filter 84.

Thus, ads are delivered to the ad filter 84 in Zigmond, filtered down to the repository, and then are provided to the switch. Programming is provided to the left of the video switch 90 and the mixed media from the switch is then output for display at the display 58. Any other interpretation of the Zigmond patent is untenable. Zigmond simply does not teach a cache, coupled to the receiver that stores both the content and the advertisement.

Still further support for the Applicants' interpretation that the content is streamed, not stored, may be found in the second paragraph of Zigmond's summary and objects of the invention. There, Zigmond explains that a conventional video programming feed is displayed to a viewer. The advertisements are either stored in the advertisement repository for later display or made available to the home entertainment system at an appropriate time. However, the programming is provided as a video programming feed (not from a stored source). See Zigmond, column 4, lines 16-24. The programming feed is the streaming television signal or the like, as described above.

As still additional evidence that the content is being streamed in Zigmond, it is stated in column 6, line 12, that "for purposes of convenience, the invention is described herein by making primary reference to insertion of advertisements into a video programming stream." Since he is talking about a video programming stream, both in the text and in the figures, where he shows the programming delivery, there is clearly no intent to store the programming or content. Instead, Zigmond only stores the advertisements and, therefore, cannot fall within the claimed language calling for a cache coupled to the receiver storing the content and the advertisement.

New claim 31 also calls for allowing the use of the cached content, and *during the use of the content, detecting a change in the use of the content from a playback mode to another mode*, and in response to said detecting, retrieving an advertisement to display an advertisement during the another mode. Zigmond does not contemplate monitoring for changes in how the content is being used on a system such as a user pausing the display of the content, and in response thereto displaying an advertisement. Zigmond merely inserts advertisements while streaming video to

an ad insertion device. *See* Figures 3, 4, 5, and 6; column 4, lines 16-18. Additionally, Zigmond typically inserts advertisements in the streaming video at times that *coincide with the advertisements originally carried on the video programming feed*. Column 4, lines 36-52. In this way, advertisements originally carried on the video programming feed are effectively overwritten. *Id.*

One embodiment of Zigmond is not dependent upon the position of conventional advertising slots. In this embodiment, the streamed video programming may be paused per a delay code that is embedded in the video programming. Column 16, lines 30-43. That is, the delay code functions to pause the programming. *Id.* Without the delay code, the programming would not be paused. Thus, this embodiment of Zigmond does not address displaying advertisements in response to a viewer's action such as temporarily stopping, or pausing a program. Simply, Zigmond does not monitor for changes in how the programming is being used on the receiver as a triggering event; his triggering events are all transmitted signals, whether actual or implied. *See also* column 15, lines 45-65. For at least these reasons, claim 31 and claims dependent thereon are patentably distinguished over Zigmond and Dedrick.

New claim 41 is also patentable over Zigmond and Dedrick. Claim 41 recites store content, including an interruptible content portion, and an advertisement in a cache coupled to a receiver, and find a place to insert the advertisement while the portion is still stored in the cache. As explained above, Zigmond does not store content. In particular, Zigmond streams video to the ad insertion device, which outputs the video for display, without storing the video on the device. *See* Figures 3, 4, and 5. Thus, Zigmond cannot find a place to insert an advertisement in the cached content before the cached content is streamed out. Nothing of the sort is possible in Zigmond and Zigmond clearly and explicitly teaches away from the claimed arrangement. Zigmond only caches the advertisements. Zigmond's streaming of the video and quickly inserting the stored advertisements is, according to the present Applicants, a less desirable approach. Zigmond does not determine where to place the advertisement within the content while the content is still stored in the cache. Specifically, he never stores the content in a cache. Moreover, he apparently makes the insertion decision in real time as the content is streaming through his system. Therefore, he does not make the decision while the content is still stored in the cache. Instead, Zigmond decides where to place the advertisement while the content is streaming through a switch.


The claimed invention admits of at least two possibilities. One is the advertisement is physically placed into the interruptible content portion while the portion is still stored in the cache. The other possibility is that while the portion is still stored in the cache, a decision of where within the content the advertisement will be placed is made, even though it may not be instituted while the content is still stored in the cache. The Applicants' approach is a fundamentally different approach that merits patent protection. For at least these reasons, new claim 41 and claims dependent thereon are patentable over Zigmond and Dedrick.

Under a similar analysis, new claim 51 and claims dependent thereon are also patentable over Zigmond and Dedrick.

In consideration of the remarks and amendments herein, the application is believed to be in condition for allowance. The examiner's prompt action in accordance therewith is respectfully requested. The commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to Deposit Account No. 20-1504 (BKA.0009US).

Respectfully submitted,

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